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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/486,066	06/07/95	ENGELHARDT	D ENZ (DS) (C2)

HM22/0928

ENZO DIAGNOSTICS, INC.
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EXAMINER	
MARSCHEL, A	
ART UNIT	PAPER NUMBER
1655	43

DATE MAILED: 09/28/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/486,066

Applicant(s)
Engelhardt et al.

Examiner
Ardin Marschel

Group Art Unit
1655



☒ Responsive to communication(s) filed on Nov 20, 1998

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 238-272, 274-297, 299-308, and 310-338 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 272, 274-297, 299-305, and 307 is/are allowed.

☒ Claim(s) 309, 310-313, 315, 316, 319, 325, 326, 329-333, and 336-338 is/are rejected.

☒ Claim(s) 238, 240-243, 245, 246, 249, 255, 256, 262, 264, 265, 267-271, 306 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1655.

The granting of the Petition to Revive with a 1.129(a) Petition is acknowledged. Accordingly, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.129(a). Applicants' submission after final, filed on 11/20/98, has been entered.

Applicants' arguments, filed 11/20/98, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

The specification lacks a section directed to "Brief Description of the Drawings" as required in 37 CFR § 1.74.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 238, 240-243, 245, 246, 249, 255, 256, 262, 264, 265, 267-271, 306, 308, 310-313, 315, 316, 319, 325, 326, 329-333, and 336-338 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Kourilsky et al. (GB 2,019,408).

Kourilsky et al. discloses the preparation of nucleotide, deoxynucleotides, and oligomers thereof with biotin labels as well as mercury and SH groups on page 2, lines 34-52. The polynucleotides attached to a particular nucleotide via the sugar-phosphodiester backbone meets the requirements of the instantly claimed and linked Sig moieties attached to a nucleotide with a phosphate moiety also attached.

Claims 244, 247, 248, 250-254, 257-261, 263, 266, 314, 317, 318, 320-324, 327, 328, 334, and 335 are now objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 272, 274-297, 299-305, and 307 are allowed.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.129(a) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.129(a).

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the submission under 37 CFR 1.129(a). See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-

Serial No. 08/486,066

- 4 -

Art Unit: 1655

4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

September 27, 1999

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER